



UNITED STATES PATENT AND TRADEMARK OFFICE

KS

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,124	10/17/2001	Allan Green	26-98A	9503

7590 12/29/2004

John P. White, ESQ
COOPER & DUNHAM LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

MCELWAIN, ELIZABETH F

ART UNIT	PAPER NUMBER
----------	--------------

1638

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

091981,124

EXAMINER

McElwan

ART UNIT	PAPER
----------	-------

1638

20041214

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

See the attached Notice of Non-Responsive Amendment.



Elizabeth F. McElwain, Ph.D.
Primary Examiner
Art Unit: 1638

Response to Amendment

1. The reply filed on October 18, 2004 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicants have cancelled all of the original claims and submitted new claims, and stated that all of the newly submitted claims should be examined in the response filed June 21, 2004. However, applicants did not elect one of the groups set forth in the restriction requirement, and the claims submitted by Applicant are non-elected by original presentation in that they don't correspond to any of the groups set forth in the restriction requirement. In the present response, Applicants have still not elected one of the groups set forth in the restriction requirement. Instead, Applicants have argued that the newly submitted claims were filed "before an action" and therefore, should be treated as original claims.

2. However, the issuance of the restriction requirement is an office action. Therefore, the claims filed June 21, 2004 were submitted after an office action had been sent. Applicants have inserted in brackets "[on the merits]" after the phrase "before an action", and have explained in a footnote that "the term 'action' is consistently used to refer to action on the merits", while restrictions are referred to as "restriction" or "requirement". The Examiner disagrees with this reasoning. A restriction requirement is issued as an office action and is accompanied by the PTO-326 Office Action Summary form. In addition, the section of the MPEP 818.02 referred to by Applicants, expressly states when "office action" means "office action on the merits". See the second paragraph of MPEP 818.02(a), where it states "claims originally presented and acted upon by the Office on their merits", while the preceding sentence recites that claims can be added and considered as original claims for purposes of

Art Unit: 1638

restriction only “before an action is given”. In this sentence, it does not specify that the “action” would have to be an “action on the merits”, as is clearly stated in the following sentence.

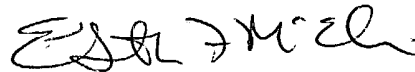
3. As stated in the previous Letter of Non-Responsive Amendment, Applicants must elect a group set forth in the restriction requirement and provide claims that correspond to that group. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (571) 272-0802. The examiner can normally be reached on increased flex time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1638

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elizabeth F. McElwain, Ph.D.
Primary Examiner
Art Unit 1638

EFM